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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,938	02/07/2002	Robert John Mulligan	CM01562L	9852

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MOTOROLA, INC
INTELLECTUAL PROPERTY SECTION
LAW DEPT
8000 WEST SUNRISE BLVD
FT LAUDERDAL, FL 33322

EXAMINER

CHIANG, JACK

ART UNIT PAPER NUMBER

2642

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,938

Applicant(s)

MULLIGAN ET AL.

Examiner

Jack Chiang

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-41 is/are pending in the application.
- 4a) Of the above claim(s) 17-25 and 35-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-34, 40-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

RESTRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 26-41, drawn to a housing having a substance that changes appearance, classified in class 379, subclass 433.01.
 - II. Claims 17-24, drawn to a housing have layers containing a fluid, classified in class 455, subclass 90.3.
 - III. Claims 25, drawn to a housing having layers containing fiber optics, classified in class 359, subclass 516.

2. The inventions are distinct, each from the other because:

Inventions Groups I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions involve Group I which requires a housing made from a specific substance. Group I does not require the combination of the layers and the fluid as it is required in Group II, nor the layers and fiber optics as required in Group III.

3. The application also contains the following species:

This application contains claims directed to the following patentably distinct species of the claimed invention:

In Group I, claims 26-41:

Specie 1, claims 27-28, 30-31, 33, 41, drawn to the substance,

Specie 2, claim 35, drawn to a switch,

Specie 3, claim 36, drawn to a software,

Specie 4, claim 37, drawn to a processor,

Specie 5, claim 38, drawn to a computer,

Specie 6, claim 39, drawn to components for receipting a message.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 26, 29, 32, 34 and 40 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Ms. Randi Karpinia (Reg. No. 46148) on 04-11-05 a provisional election was made without traverse to prosecute the invention of **Specie 1 in Group I, claims 26-34 and 40-41**. Affirmation of this election must be made by applicant in replying to this Office action. **Claims 17-25 and 35-39** have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

CLAIMS

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 26-34, 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Lehtiniemi et al. (US 6466299).

Regarding claim 26, Lehtiniemi shows a housing (fig. 1) comprising:

An outer visible surface (C) which is composed of a sensory producing substance (A1-A4) responsive to a change in a surrounding physical environment (col. 1, lines 58-67).

Regarding claim 29, Lehtiniemi shows a housing (fig. 1) comprising:

An outer visible surface (C) having at least one shape element (see A1-A4) composed of a sensory producing substance (A1-A4) responsive to a change in a surrounding physical environment (col. 1, lines 58-67).

Regarding claim 32, Lehtiniemi shows a housing (fig. 1) comprising:

An outer visible surface (C) having at least one shape element (see A1-A4) composed of a sensory producing substance (A1-A4) responsive to a stimulus generated by a plurality of internal components (col. 1, lines 58-67).

Regarding claim 34, Lehtiniemi shows a housing (fig. 1) comprising:

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An outer visible surface (C) which is composed of an appearance changing substance (A1-A4) adjustably responsive to a change in a surrounding physical environment (col. 1, lines 58-67, col. 4, lines 20-58).

Regarding claim 40, Lehtiniemi shows a housing (fig. 1) comprising:

An outer visible surface (C) having at least one shape element (see A1-A4) composed of an appearance changing substance (A1-A4) responsive to one or more operation of a plurality of internal components (col. 1, lines 58-67, col. 4, lines 20-58).

Regarding claims 27-28, 30-31, 33, 41, Lehtiniemi shows:

The housing (fig. 1);

The sensory producing substance is a combination of one or more substances selected from a group comprising a thermal producing substance, a vibration producing substance, and a haptic producing substance (col. 1, lines 58-67);

The sensory producing substance causes the housing to provide to a user one or more sensations selected from a group comprising heat, pressure, and texture (col. 1, lines 58-67, col. 2, lines 3-14);

The stimulus is a combination of one or more stimuli selected from a group consisting of an acoustic, a thermal, an electrical, an electromagnetic, an olfactory, and a mechanical stimulus (col. 1, lines 58-67);

The one or more operations is selected from a group comprising a light from a keypad, light from a display, a vibration from an alerting mechanism, an audible alert from a speaker (col.1, lines 66-67, col. 4, lines 39-46, col. 8, lines 16-19).

ARGUMENT

9. In response to the remarks filed on 02-10-05 (pages 7-8), applicant has submitted new claims, and they are rejected as anticipated by Lehtiniemi, see rejection above.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 571-272-7483. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JACK CHIANG
PRIMARY EXAMINER